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09/888,298	06/22/2001	Ian E. Smith	D/A1053lharris/xerx/1051.	9531
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FLIESLER MEYER, LLP FOUR EMBARCADERO CENTER SUITE 400 SAN FRANCISCO, CA 94111			COFFY, EMMANUEL	
			ART UNIT	PAPER NUMBER
			2157	

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/888,298

Applicant(s)

SMITH ET AL.

Examiner

Emmanuel Coffy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 10 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Amendment***

1. This action is responsive to the amendment filed on February 10, 2005. Claims 1, 20, and 22 are amended. Claims 1-23 are pending and represent a method, system and article of manufacture for an "Active Electronic Messaging System."

***Response to Arguments***

2. In the remarks, applicant argues that "the current claims, unlike Tilden, Jr. are not limited to making use of information on a user's website. Rather, the current claims allow integration of functions and capabilities available on any website located anywhere in the world, with no limitation on the identity of the website's operator." (applicant's remarks, page 12.) Applicant further stated that Tilden Jr. fails to disclose all the limitations of claims 1 and 17.

Applicant is directed to Fig.1 (34), and (28) a web browser program and web server program are disclosed respectively. Index 14 discloses a network. Figs. And 4 further disclose functions and capabilities encompassing a global reach.

Tilden Jr. is directed to a data distribution system which includes a server computer for transmitting email files to a computer network for access by remote computers. (emphasis added) (See abstract.)

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

3. Applicant next argued that the references cited in the Office Action, including Tilden, Jr. and Borenstein, either singly or in combination, fail to disclose all of the limitations of claims 4, 6 and 11-12. (applicant's remarks, page 13.)

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

4. Applicant further argued that Tilden Jr. does not disclose determining an application provider; and that Borenstein makes no disclosure regarding determining an application provider. (applicant's remarks, page 14.) Applicant further asserted that Borenstein discloses nothing regarding alteration of the destination address. (applicant's remarks, page 15.)

In response to applicant's arguments against the reference individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

5. Lastly, applicant asserted that a citation to col. 6, lines 18-25 of Tilden Jr. (applicant's remarks, page 14.) for the teachings that a script program which contains a

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command which performs a task in response to a user's request is incorrect. Upon review of col. 6, lines 18-25, the disclosure of a script program is not as accentuated as it is in col. 2, lines 7-8, 13-19, 27-29 and 51-54.

6. Applicant's arguments have thus been fully considered but they are not persuasive. In response to Applicant's arguments, 37 CFR § 1.111(c) requires applicant to "clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made.

7. The claims stand rejected as articulated in the First Office Action (see below) and all objections not addressed in Applicant's response are herein reiterated.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-3, 8, 9, 13, 15-23 directed to a method, article of manufacture and apparatus are rejected under 35 USC 102(e) as being clearly anticipated by Tilden, Jr. et al. (US 6,449,635).

Tilden substantially teaches the invention as claimed including a script program as a portion of a secondary e-mail message that also includes tracking information; a

predefined message is also stored as a main message, the script program also including a command that displays the predefined message by retrieving the second source file. (See abstract).

Claim 1:

Referring to claim 1, it recites a method for enhancing the functionality of an electronic message, comprising the steps of:

receiving the electronic message; (See col.2, line 49)

obtaining a command instruction from the electronic message; and (See col. 2, lines 51-61).

performing a function responsive to the command instruction. (See col. 9, line 44-47)

Claim 2:

Referring to claim 2, it recites the method of claim 1, wherein the command instruction indicates an application provider for performing the function. (See col. 6, lines 21-25).

Claim 3:

Referring to claim 3, it recites the method of claim 1, wherein the command instruction is a Uniform Resource Locator ("URL"). (See col. 5, lines 30-34).

Claim 8:

Referring to claim 8, it recites the method of claim 1, wherein the command instruction includes:

a host and a file which indicate an application provider for performing the function; and (See col. 4, line 67-col. 5, line 2; lines 20-30).

at least one parameter which indicates information to be delivered to the application provider. (See col. 5, lines 33-38).

Claim 9:

Referring to claim 9, it recites the method of claim 1, wherein the command instruction is included in the received message as an Internet shortcut file. (See col. 5, lines 42-47). (it is inherent that http:// refers to the internet.)

Claim 13:

Referring to claim 13, it recites an article of manufacture whereas claim 2 recites a method. However, the limitation claimed in 13 does not reveal to be different from the one recited in claim 2. Therefore, this claim is rejected for the same reason as claim 2.

Claims 15-16, and 19-23

Claims 15 and 16 recite an article of manufacture and claims 19-23 recite an apparatus whereas claims 8, 9 and 10 recite a method. However, the limitations claimed in 15-16 and 19-23 do not reveal to be different from the ones recited in claims 8-10. Therefore, these claims are rejected for the same reason.

Claim 17:

Referring to claim 17, it recites an apparatus for providing a function responsive to receiving a Request, comprising:

a processor; and (See Fig. 1)

a processor readable storage medium in communication with the processor, containing processor readable program code for programming the apparatus to: (See Fig. 1)

receive the Request; (See col. 8, lines 37-39).

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perform a function responsive to an instruction included in the Request; and,

(See col. 8, claim 2; col. 9, line 3).

prepare a Response subsequent to performing the function. (See col. 4, lines 63-67).

Claim 18:

Referring to claim 18, it recites the apparatus of claim 17, wherein the Response includes instructions and data, wherein the instructions include information for disposal of the data. (See col. 9, claims 13 and 14.)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 4-7, and 11-12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tilden, Jr. et al. (US 6,449,635) in view of Borenstein (WO 92/22033.)

Tilden substantially teaches the invention as claimed including a script program as a portion of a secondary e-mail message that also includes tracking information; a predefined message is also stored as a main message, the script program also including a command that displays the predefined message by retrieving the second source file. (See abstract).

Claim 4:

Referring to claim 4, it recites the method of claim 1, wherein the step of performing a function includes the steps of:

determining an application provider from the command instruction; and  
sending a Request to the application provider to perform the function.

Tilden teaches a script program which contains a command which performs a task in response to a user's request. (See col. 6, lines 18-25). Tilden does not explicitly disclose determining an application provider. However, Borenstein does so at page 4, lines 1-6. Hence, it would have been obvious for an artisan of ordinary skill in the art to combine the teachings of Tilden with the application provider determining process disclosed by Borenstein. Such system provides for the automation of routine tasks. Therefore, claim 4 is rejected.

Claim 5:

Referring to claim 5, it recites the method of claim 4, including the step of: preparing the Request based on the command instruction.

Tilden teaches a script program which contains a command which performs a task in response to a user's request. (See col. 6, lines 18-25). Tilden does not explicitly disclose preparation of the request based on the command instruction. However, Borenstein discloses at page 2, lines 7-8 that an active message is a program that is run. It is therefore, implicit that a program can execute any step as implemented.

Hence, it would have been obvious for an artisan of ordinary skill in the art to combine the teachings of Tilden with the application provider determining process disclosed by Borenstein. Such system provides for the automation of routine tasks.

Claim 6:

Referring to claim 6, it recites the method of claim 4, further including the steps of: receiving a Response from the application provider; and modifying the message responsive to receiving the Response.

Tilden teaches a script program which contains a command which performs a task in response to a user's request. (See col. 6, lines 18-25). Tilden does not explicitly disclose preparation of the request based on the command instruction. However, Borenstein discloses at page 2, lines 7-8 that an active message is a program that is run. It is therefore, implicit that a program can execute any step as implemented.

Hence, it would have been obvious for an artisan of ordinary skill in the art to combine the teachings of Tilden with the application provider determining process disclosed by Borenstein. Such system provides for the automation of routine tasks. Therefore, claim 6 is rejected.

Claim 7:

Referring to claim 7, it recites the method of claim 6, further including the step of: sending the modified message to a destination.

Tilden teaches a script program which contains a command which performs a task in response to a user's request. (See col. 6, lines 18-25). Tilden does not explicitly disclose preparation of the request based on the command instruction. However, Borenstein discloses at page 2, lines 7-8 that an active message is a program that is run. It is therefore, implicit that a program can execute any step as implemented.

Hence, it would have been obvious for an artisan of ordinary skill in the art to combine the teachings of Tilden with the application provider determining process

disclosed by Borenstein. Such system provides for the automation of routine tasks.

Therefore, claim 7 is rejected.

Claim 11:

Referring to claim 11, it recites an article of manufacture including an information storage medium wherein is stored information for programming a computer to:

receive an electronic message having a destination address;

alter the destination address of the message; and

send the message based on the altered destination address.

Tilden teaches a script program which contains a command which performs a task in response to a user's request. (See col. 6, lines 18-25). Tilden does not explicitly disclose alteration of the destination address. However, Borenstein discloses alteration of the destination address at page 4, lines 13-17.

Hence, it would have been obvious for an artisan of ordinary skill in the art to combine the teachings of Tilden with the alteration process disclosed by Borenstein. Such system provides for the automation of routine tasks. Therefore, claim 11 is rejected.

Claim 12:

Referring to claim 12, it recites an article of manufacture wherein information is stored for programming a computer as in claim 11, wherein the altered destination address identifies a computing device which will perform a function on the message.

Tilden teaches a host as a computing to perform a function on the message. (See col. 4, line 67-col. 5, line 2). Tilden does not explicitly disclose alteration of the

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destination address. However, Borenstein discloses alteration of the destination address at page 4, lines 13-17.

Hence, it would have been obvious for an artisan of ordinary skill in the art to combine the teachings of Tilden with the alteration process disclosed by Borenstein. Such system provides for the automation of routine tasks. Therefore, claim 12 is rejected.

11. Claim 10 is rejected under 35 U.S.C. §103(a) as being unpatentable over Tilden, Jr. et al. (US 6,449,635) in view of Borenstein (WO 92/22033.) in further view of Richard (US 6,728,711).

Tilden substantially teaches the invention as claimed including a script program; a predefined message is stored as a main message, the script program also including a command that displays the predefined message by retrieving the second source file (See abstract).

Claim 10:

Referring to claim 10, it recites the method of claim 4, wherein the Request is sent using an HTTP POST command.

Tilden teaches a script program which contains a command which performs a task in response to a user's request. (See col. 6, lines 18-25). Tilden does not explicitly disclose determining an application provider. However, Borenstein does so at page 4, lines 1-6. Hence, it would have been obvious for an artisan of ordinary skill in the art to combine the teachings of Tilden with the application provider determining process disclosed by Borenstein. Such system provides for the automation of routine tasks.

Neither Tilden nor Borenstein disclose HTTP Post. However, Richard does. (See abstract).

Hence, it would have been obvious for an artisan of ordinary skill in the art to combine the teachings of Tilden and the application provider determining process disclosed by Borenstein with HTTP POST as disclosed by Richard. Such system provides for the automation of back-up and restoration tasks.

### **Conclusion**

#### **12. THIS ACTION IS MADE FINAL.**

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emmanuel Coffy whose telephone number is (571) 272-3997. The examiner can normally be reached on 8:30 - 5:00 P.M.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Emmanuel Coffy  
Patent Examiner  
Art Unit 2157

\*\*\*EC  
March 9, 2005



SALEH NAJJAR  
PRIMARY EXAMINER